

REMARKS

Claims 1-17, 19-21 and 23 are currently pending in this application. By this Reply, Applicant has amended claims 1, 2, 12-17, 21 and 23. Accordingly, claims 1-17, 19-21 and 23 are at issue. Applicant respectfully submits no new matter is added by these amendments.

Applicant notes the objection to claim 21 because of certain informalities has been withdrawn.

The Examiner has rejected claims 1, 2, 4-9, 11-13, 15, 17, 19, 20, 21 and 23 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,909,368 by Nixon in view of U.S. Patent 5,878,257 by Nookala. Applicant respectfully traverses this rejection.

Claim 1 is directed to a control system having an automation device and a network device connected by a network. The network device stores a plurality of customized application programs that can be used to control the automation device. The method of claim 1 requires that “one customized application program of the plurality of customized application programs controls the automation device, and is selected by the network device in response to a specific application program request message for the one customized application program....” Accordingly, the automation device determines which of the plurality of application programs stored in the network device is downloaded to the automation device.

The system of Nixon does not disclose a control system in accordance with claim 1. Instead, a user in Nixon requests the control routine through a workstation coupled to a controller. The system of Nixon includes field devices, controllers coupled to the field devices and workstations coupled to the controllers. The workstations include a user interface for “providing display screens for enabling the user to select methods or programs that perform the new or modified function for the particular control template.” (See Nixon, col. 10, lines 13-32).

In contrast to the method of claim 1, in Nixon, “a user selects the program to be downloaded.” (See Office Action of May 3, 2005, page 12, lines 18-19, or, Nixon, col. 7, lines 8-13, “Main PC2 is configured to generate, in response to user input commands, various control routines that are provided via the CAN 3 to one or more local controllers identified as elements 4 and 5 which implement the control strategy defined by the control routines selected and

established in main PC 2”). That is, unlike the method of claim 1, the application program of Nixon is not selected by the automation device’s application program request message.

As set forth above, Nixon fails to disclose each of the limitations of claim 1. Nookala does not cure these failures. According to the Office Action of May 3, 2005, Nookala discloses a program request message can be sent from the device requiring the programming. Nookala does not disclose selection of one of a plurality of programs by an automation device. Accordingly, for the reasons given above, Applicant respectfully submits claim 1 is patentable over Nixon in view of Nookala.

Claims 2, 4-9 and 11 depend on claim 1, either directly or indirectly, and include each of its limitations. Accordingly, Applicant respectfully submits claims 2, 4-9 and 11 are also patentable over Nixon in view of Nookala.

Claim 12, as amended herein, is directed to a method of operating a control system. Claim 12 requires, “selecting the requested customized application program in response to the message for requesting one customized application program of the plurality of customized application programs.”

As set forth above, neither Nixon nor Nookala discloses a system wherein the automation device is requesting the application program. Accordingly, Applicant respectfully submits claim 12 is patentable over Nixon in view of Nookala.

Claims 13 and 15 depend on claim 12, and include each of its limitations. Accordingly, Applicant respectfully submits claims 13 and 15 are also patentable over Nixon in view of Nookala.

Claim 17, as amended herein, requires “means for transmitting a message by the automation device requesting one customized application program of the plurality of customized application programs as part of a bootstrap protocol;” and “means for selecting the one customized application program in response to the message requesting the one customized application program.”

As set forth above, neither Nixon nor Nookala discloses a system wherein the automation device is requesting the application program. Accordingly, Applicant respectfully submits claim 17 is patentable over Nixon in view of Nookala.

Claims 19 and 20 depend on claim 17, and include each of its limitations. Accordingly, Applicant respectfully submits claims 19 and 20 are also patentable over Nixon in view of Nookala.

Claim 21, as amended herein, requires “requesting one customized application program of the plurality of customized application programs by the automation device as part of a bootstrap protocol;” and “selecting the one customized application program.”

As set forth above, neither Nixon nor Nookala discloses a system wherein the automation device is requesting the application program. Accordingly, Applicant respectfully submits claim 21 is patentable over Nixon in view of Nookala.

Claim 23 depends on claim 21, and includes each of its limitations. Accordingly, Applicant respectfully submits claim 23 is patentable over Nixon in view of Nookala.

Additionally, there is no incentive or motivation in the prior art to make the combination proposed by the Examiner. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, there is no incentive in the cited references to combine the references in the manner suggested by the Examiner. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. See MPEP § 2142. In the present case, the

Examiner failed to meet this burden and simply concludes it would have been obvious to combine the references.

It is apparent the Examiner took isolated features from the cited references, and has used the claims of the present application as a template. Such hindsight reconstruction is improper. It is well-recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 (“one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

The Examiner has rejected claims 3, 14 and 16 under 35 U.S.C. 103(a) as being unpatentable over Nixon and Nookala as applied to claims 2, 12 and 15, and further in view of “A Customizable Library to support Software Synthesis for Embedded Applications and Micro-Kernel Systems” by Ditze. Applicant respectfully traverses this rejection.

Claim 3 depends indirectly on claim 1, and includes each of its limitations. As set forth above, Nixon in view of Nookala fails to disclose each of the limitations of claim 1. Ditze does not cure these failures. According to the Office Action of May 3, 2005, Ditze discloses that the executive code can be selected based on the user code. Accordingly, for the reasons given above with respect to claim 1, Applicant respectfully submits that claim 3 is patentable over Nixon in view of Nookala and in further view of Ditze.

Claims 14 and 16 depend either directly or indirectly on claim 12, and include each of its limitations. Accordingly, for the reasons given above with respect to claim 12, Applicant respectfully submits that claims 14 and 16 are patentable over Nixon in view of Nookala and in further view of Ditze.

Additionally, the Examiner has again failed to show an incentive or motivation in the prior art to make the proposed combination.

The Examiner has rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Nixon in view of Nookala and in further view of U.S. Patent 6,788,980 by Johnson. Applicant respectfully traverses this rejection.

Claim 10 depends directly on claim 1, and includes each of its limitations. As set forth above, Nixon in view of Nookala fails to disclose each of the limitations. Johnson does not cure

these failures. According to the Office Action of May 3, 2005, Johnson discloses that ControlNet is a well known protocol in relation to field devices. Accordingly, for the reasons given above with respect to claim 1, Applicant respectfully submits that claim 10 is patentable over Nixon in view of Nookala and in further view of Johnson.

Additionally, the Examiner has again failed to show an incentive or motivation in the prior art to make the proposed combination.

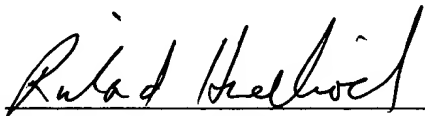
CONCLUSION

In light of the foregoing Remarks, Applicant respectfully submits pending claims 1-17, 19-21 and 23 are in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of claims 1-17, 19-21 and 23. The Examiner is invited to contact the undersigned at the number below if there are any questions concerning this Response.

The Commissioner is authorized to debit or credit Deposit Account No. 23-0280 for any payment **deficiencies or overpayments** associated with this matter.

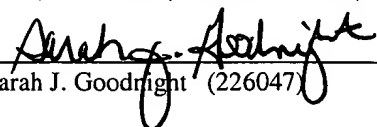
Respectfully submitted,

Dated: July 21, 2005

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on July 21, 2005.


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